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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,549	01/07/2000	E. MICHAEL ACKLEY, JR.	2280.2470	3198

5514 7590 01/20/2004

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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT PAPER NUMBER

1761

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/479,549

Applicant(s)

ACKLEY, JR. ET AL.

Examiner

Steven L. Weinstein

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 153).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 9, 10, 12 and 59-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 9, 10, 12 and 59-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 9, 10, 12 and 59-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ream et al (WO'075) in view of Redford et al (WO '884) further in view of Yamamoto et al ('252) and Krubert ('273), further in view of Van Os (5,553,536), Karlyn et al (5,165,340), Karlyn et al (5,429,045) and Averill et al (5,730,048).

In regard to claim 1, Ream et al discloses a method to form multicolor images in substantial registration on edible pieces comprising the steps of printing a first image in a first color on a surface of the edible piece to form a printed piece at a first printing station, transporting the printed piece to a second printing station and maintaining a registering relationship of the printed piece from the first printing station to the second printing station, and printing a second image in a second color in registration with the first image on the printed piece while maintaining the registering relationship. For example, Ream et al discloses "printing in register with one another" (page 3), "the multiple colors are in registration with one another" (page 4), etc. Ream et al teaches that the pieces are transported in a recess or depression (page 14), that the pieces could be adjusted to insure registration for registered printing and that vacuum could be provided to help hold down the pieces. As noted previously, the phrase pressure differential could be some type of physical/mechanical hold down clamp positioned above the shaped pieces and not the disclosed vacuum type differential pressure. In any case, as

evidenced by Redford et al and further evidenced by Van Os ('536), Karlyn et al ('045) and Averill et al ('048), the printing art is replete with examples of using pressure differential (e.g. vacuum) in processes wherein articles are to undergo two or more steps to impart indicia or images onto the articles and where it is necessary to maintain the articles in a set position so that these steps occur in registration to achieve a good result. Redford et al, for example, discloses using vacuum from a printing step through an etching step in registration, to perfect an image. Van Os, Karlyn et al ('340), Karlyn et al ('045) and Averill et al ('048) all teach using vacuum throughout a printing process so that the articles are maintained in registration with two or more printing stations. This is exactly applicant's objective as well. Claim 1 now recites that the surface that is printed is non-planar. As noted previously, applicant is not the first to print on a non-planar surface and applicant is not the first to perform dual operations on a non-planar surface. Redford et al clearly evidences both of these expedients. Yamamoto et al and Krubert are relied on as previously as further evidence of fixing a shaped edible in a recess in a moving surface during printing and multicolor printing, respectively. Claim 9 is rejected for the reasons given above in regard to claim 1. In regard to claim 59, claim 59 is also rejected over the art applied and for the reasons given in regard to the rejection of claim 1 above. In regard to the recitation that the recesses are curved in correspondence to the pieces, it would have been an obvious matter of design and an obvious function of the shape of the pieces to be printed to make the shape of the recesses curved in correspondence to the pieces. See, for example, in this regard Redford et al, Figure 2. In regard to claims 61-64, the shape of the pieces, their size and any shell, are all seen to have been an obvious function of the particular product one chooses to be printed. The claims describe candies such as "M&M's" and applicant is certainly not the

inventor of lentil shaped, sugar shell, "M&M's". Also, further in regard to claim 64, it is conventional to dry printing before a second printing is applied (e.g. Van Os). In regard to claim 65, Redford et al teaches it was conventional to configure the recess so that the non-planar surface of an edible piece extends above the recess.

All of applicant's remarks filed September 5, 2003 have been fully and carefully considered but are not found to be convincing for the reasons given above. It is noted that the amendment urges that there is no one reference that teaches multicolor printing (i.e. two step printing) on curved surfaces. As applicant discloses, it is the vacuum in the recess that allows the pieces to be maintained in the same exact position so that both printing steps are in registration. However, the art taken as a whole teaches using vacuum to fix articles to be multicolor printed in two or more printing steps, and the art also teaches employing vacuum to fix curved articles for both a single printing step and for a second step that modifies the printing step and requires the article to be remain fixed. Thus, vacuum has been associated with curved article printing and a second step requiring registration and vacuum has been associated with multiple color printing steps. Contrary to what has been urged, there is seen to be nothing magic in employing vacuum with two printing steps on a curved product. If vacuum has been used on curved surfaces requiring registration between a printing step and a printing modification step, and vacuum has been used with articles undergoing two printing steps requiring registration, one would fully expect (and be fairly led) that vacuum would be useful in printing curved surfaces with multiple printing steps.

Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is 571-272-1410. The examiner can generally be reached on Monday-Friday from 7:00 a.m. to 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application is assigned are 703-872-9306 for both regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

S. Weinstein/dh  
December 11, 2003



STEVE WEINSTEIN  
PRIMARY EXAMINER

1761

1/11/04